APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/434,992	11/05/1999	JOSEPH M. CANNON	90-81-39	4633

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EXAMINER
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ART UNIT	PAPER NUMBER
2643	

DATE MAILED: 02/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____ .

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-34* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-34* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

     If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All b)☐ Some * c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____ .

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

     a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐	Notice of References Cited (PTO-892)	4) ☐	Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐	Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) ☐	Notice of Informal Patent Application (PTO-152)
3) ☐	Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) ☐	Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) do not apply to the examination of this application as the application being examined was

not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b).

Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the

AIPA (pre-AIPA 35 U.S.C. 102(e)).

2.   Claims 1-5, 11-14, 15, 21-24, 26, 28 are rejected under 35 U.S.C. 102(e) as being

anticipated by Reuben et al (5,467,385).

        Consider claims 1-3, 5, 11-13, 15, 21-23, 26, 28. Reuben teaches a caller ID device (see

fig. 1, CID recorder 10) comprising a memory (col. 12, ln. 8-14) adapted to store caller ID data

associated with an incoming call; and a processor (fig. 2, control logic 38) adapted to selectively

store the caller ID data based on an off-hook status of a telephone (the call is answered by

answering machine 17; abstract; col. 2, ln. 14 to col. 5, ln. 10). Reuben's Col. 9, ln. 4-5 discloses

that the control logic 38 processes CID data output 36 which is **temporarily** stored in the SRAM

84 as processed data 74. Reuben's fig. 2-4; col. 9, ln. 35 to col. 12, ln. 46, **especially col. 12, ln.**

6-14, clearly show that the control logic only decides to store the CID when the answering

machine (17) goes off-hook by detecting the answering machine status (answering machine status

detector 20) and (line status detector 24). It is clearly that the SRAM is only functioning as a

buffer to temporarily stores the CID information before determining the off-hook status of the

telephone 12 and the answering machine 17. It is further noted that modern answering machine

utilizes the use of electrical erasable memory device as its storage device, instead of a cassette

tape.

Consider claims 4, 14, 24. Reuben further teach the off-hook status relates to whether an

answered call is answered by a person or by a machine (the call is answered by answering machine

17; abstract; col. 2, ln. 14 to col. 5, ln. 10). Furthermore, fig. 2 and (col. 9, ln. 35 to col. 12, ln.

46) clearly shows that the control logic only stores CID when the answering machine (17) goes

off-hook by detecting the answering machine status (answering machine status detector 20) and

(line status detector 24).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 6, 16, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reuben et al (5,467,385) in view of Hirai (5,446,785).

Consider claims 6, 16, 27. Reuben does not teach the caller ID data is store in the memory with a flag indicating whether the call was answered.

Hirai teaches the caller ID data is store in the memory with a flag indicating whether the call was answered (no-response code "0"; fig. 5, 6A-B, response information; col. 13, ln. 32 to col. 14, ln. 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Hirai into the teachings of Reuben, so that answered calls can be easily distinguished from unanswered calls.

5.   Claims 7-10, 17-20, 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reuben et al (5,467,385) in view of Lim et al (5,883,942).

Consider claims 7, 17. Reuben does not teach the processor being adapted to affect storage of a plurality of previously stored caller ID data in response to a given condition.

Lim teaches the processor being adapted to affect storage of a plurality of previously stored caller ID data in response to a given condition (col. 6, ln. 20-29).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to utilize the teachings of Lim into the teachings of Reuben in order to save

memory space, since the memory space is small and limited.

Consider claims 8, 18. Lim further teaches the given condition being an indication that the

memory is more full than a predetermined threshold (a pre-determined number of incoming calls,

i.e., 20, 50 or 100; col. 6, ln. 2-29).

Consider claims 9, 19. Lim further teaches the given condition is user input (col. 6, ln. 34

to col. 8, ln. 13, especially, col. 7, ln. 10-16).

Consider claims 10, 20. Lim further teaches keypad (user interface 22).

Consider claim 25. Lim further teaches the caller ID storage decision is further based on a

blocked status of at least a portion of the received caller ID data (col. 13, ln. 20 to col. 14, ln. 17).

Consider claims 29-30. Lim further teaches the caller ID storage decision is made in

response to user input and affects caller ID data already stored (col. 6, ln. 34 to col. 8, ln. 13,

especially, col. 7, ln. 10-16).

Consider claim 31. Lim further teaches the given condition being an indication that the

memory is more full than a predetermined threshold (a pre-determined number of incoming calls,

i.e., 20, 50 or 100; col. 6, ln. 2-29).

Consider claim 32. Lim further teaches the caller ID storage decision is made in response

to user input (col. 6, ln. 34 to col. 8, ln. 13, especially, col. 7, ln. 10-16).

Consider claim 33. Lim further teaches keypad (user interface 22).

Consider claim 34. Lim further teaches the caller ID device is part of a telephone (fig. 1).

Response to Arguments

6.   Applicant's arguments filed 1/6/03 have been fully considered but they are not persuasive.

Regarding the Reuben reference, applicant states "Reuben discloses for calls where CID

information is available, the CID information is always stored in SRAM. Reuben fails to make

any decisions based on an off-hook condition." In contrast to applicant's assertions, Reuben's

Col. 9, ln. 4-5 discloses that the control logic 38 processes CID data output 36 which is

temporarily stored in the SRAM 84 as processed data 74. Reuben's fig. 2-4; col. 9, ln. 35 to col.

12, ln. 46, **especially col. 12, ln. 6-14,** clearly show that the control logic only decides to store

the CID when the answering machine (17) goes off-hook by detecting the answering machine

status (answering machine status detector 20) and (line status detector 24). It is clearly that the

SRAM is only functioning as a buffer to temporarily stores the CID information before

determining the off-hook status of the telephone 12 and the answering machine 17. The

answering machine 17 **does not always** store the CID information. Claims 1 and 11 does not call

for a processor adapted to selectively store the caller ID data [in said memory] based on an off-

hook status of the telephone. Claims 1 and 11 does not exclude the step of temporarily store the

CID in a memory buffer and later transferring the CID to a storage device (e.g., the answering

machine 17). It is further noted that modern answering machine utilizes electrical erasable memory device, instead of a cassette tape.

Conclusion

7.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Nguyen whose telephone number is (703) 308-7527.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Kuntz, can be reached on (703) 305-4708.

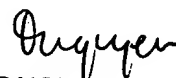**Any response to this final action should be mailed to:**

Box AF
>Commissioner of Patents and Trademarks
>Washington, D.C. 20231

or faxed to:

>**(703) 872-9314** (Group's Fax numbers)
>(703) 746-7251 (Examiner's Fax number, only for proposed amendment)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington. VA., Sixth Floor (Receptionist).

January 31, 2003

DUC NGUYEN
PRIMARY EXAMINER